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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,546	10/11/2000	Charles E Covatch	10294-539001	5745

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STAMFORD, CT 06905-5619

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HCT

**Office Action Summary**

Application No.

09/686,546

Applicant(s)

COVATCH, CHARLES E

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 12 December 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the phrase "said instep portion in lines 4 and 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudy 3,685,176. Rudy '176 discloses all the limitations of the claims including the following: footwear for protecting a foot (Figure 1); a vamp of an upper extending from a toe region to an instep region and consisting of a single continuous unit (vamp is upper 11 and is continuous from the toe region to the instep region); a liner 111 positioned beneath the instep portion and consisting of a single continuous piece (from the toe region to the instep region); an elastic instep guard 20 positioned between the instep portion and the liner to protect the metatarsal area of the user's foot; the instep guard including an elastic support having a plurality of hollow passages (see Figure 8, also see col. 4, lines 20-42); the guard extending from the toe to the instep region of the vamp (see Figure 8); the guard including a first sheet 100 and a plurality of members extending from the first sheet to define the plurality of hollow

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passages (that which forms the hollow chambers in Figure 8); the instep guard having a second sheet 101 connected to the first sheet by the support members (support members connect the sheets to form hollow tubes); the plurality of passages 24-30 are defined by the first sheet, the second sheet and a plurality of curved support members; the hollow passages are filled with air; the hollow passages are elongated (see Figure 8); the cross-section of the hollow passages is ovoid (see Figure 8); the instep guard is made of resilient material (elastomeric sheet material); the instep guard is positioned on an underside of the instep portion of footwear (see Figures 1 and 8).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudy 3,685,176 in view of Johnsen 2,988,829. Rudy '176 discloses all the limitations of the claims as noted above except for the steel toe and the guard being in contact with the steel toe and the cross-section of the support members being different. Johnsen '829 teaches that a boot can contain a steel toe 21 and an instep protector 30 used in combination where the instep protector contacts the steel toe to provide continuous protection of the upper portion of a user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a steel toe, such as that shown in Johnsen '829, in contact with the liner of Rudy '176 to aid in protecting the toe area of the shoe of Rudy '176 from heavy impacts. With respect to the limitation of the hollow tubes having at

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least two different cross-sections, this can clearly be seen in Rudy '176 as the cross section shown in Figure 5 are circular while the cross-section shown in Figure 6 are ovoid shaped.

### *Response to Arguments*

7. Applicant's arguments filed November 7, 2002 have been fully considered but they are not persuasive. With respect to applicant's arguments that the upper and liner of Rudy are split and not continuous, this argument is not clearly understood. Applicant claims that the vamp extends from the toe region to an instep region and that it consists of a single and continuous piece. The vamp of Rudy extends from the toe region to the instep region without a break in between and therefore meets the limitation of "continuous" as it is continuous from the toe to the instep region. As shown in Figure 8, the liner 111 of Rudy is shown to extend from the toe to the instep portion. As noted in the disclosure of Rudy, the bladder 20 is made to be disposed around the foot, ankle and lower leg of the user, consists of two plies 100 and 101 (see col. 4, lines 21-31). Later, it states that the inner layer 101 is covered by a layer of foam 110 which is in turn covered by an inner liner 111 (see col. 8, lines 37-41). Therefore, since the layer 101 is disposed around the foot, ankle and lower leg of the user and covered by 110 which is, in turn, covered by liner 111, liner 111 is disposed around the foot, ankle and lower leg of the user, thereby meeting the "continuous" limitation of the claim. With respect to applicant's arguments regarding Johnsen, these arguments are not clearly understood. Rudy teaches the use of an "elastic guard" as a means to protect the foot, even in the instep area. Although the insert of Johnsen is not in direct contact with the steel toe, the pad 30 is in contact with the steel toe via the insert 35, thereby meeting the broad limitation in the claim. Therefore, it would have been obvious to use the elastic guard of Rudy as the pad of Johnsen for the same purpose of protecting the user's foot. With respect to applicant's arguments directed towards hindsight, i.e. "None of the references provide any reason or logic for an elastic instep guard in contact with a steel toe...", this argument is not clearly

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understood. Both reference are directed to protecting the users foot and the mere substitution of one type of protector for another would not be beyond that skill of one of ordinary skill in the art as the protectors would perform the same function. With respect to the applicant's arguments that Rudy teaches that the bladder deflates under pressure (col. 6, lines 59-64), this argument is also not clearly understood. It appears that applicant is arguing more than that which is disclosed by Rudy. The section in which the applicant cites only states that the bladder deforms when bent thereby deforming the tubes to bend with the foot which would increase the pressure in the bladder. Therefore, the tubes do not deflate as implied by the applicant.

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

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If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
January 24, 2003